

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants: Jay S. Walker et al.

CUSTOMER NO. 22927

Application No.: 09/112,131

Filed: July 8, 1998

Title: METHOD AND APPARATUS FOR A
CRYPTOGRAPHICALLY-ASSISTED COMMERCIAL
NETWORK SYSTEM DESIGNED TO FACILITATE AND
SUPPORT EXPERT-BASED COMMERCE

Attorney Docket No.: 96-002-C1

Confirmation No.: 6549

Examiner: NGUYEN, Cuong H.

Group Art Unit: 3661

REPLY BRIEF**BOARD OF PATENT APPEALS
AND INTERFERENCES**Mail Stop: Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Appellants hereby submit remarks in this Reply Brief pursuant to 37 C.F.R. §41.41 and in response to the Examiner's Answer mailed on February 7, 2007. This Reply Brief is submitted as a supplement to the Appeal Brief mailed on November 20, 2006 (hereinafter the "Appeal Brief") and should, if applicable, be considered as a request to maintain the current appeal to the Board of Patent Appeals and Interferences from the decision of the Examiner in the non-final Office Action mailed August 25, 2005, rejecting Claims **177-189**.

REMARKS

I. Introduction

Appellants submit this Reply Brief voluntarily pursuant to 37 C.F.R. §41.41, to address the additional assertions and arguments appearing in the Examiner's Answer mailed on February 7, 2007.

II. The Claim Rejections

A. Claim 177

Appellants note that pages 4 to 6 of the Examiner's Answer contain added verbiage concerning the rejection of Claim 177, and thus Appellants submit the following remarks.

Claim 177 stands rejected under 35 U.S.C. §102(b) as allegedly anticipated by MPEP Section 705.01(e) and MPEP Section 1005.

Claim 177 requires *selecting a second expert that has a second expert qualification that is higher than the first expert qualification* (of a first expert for which a first expert qualification was received). The Examiner cited only MPEP Section 705.01(e) in support of what was allegedly known, and to prop up his interpretations of this portion of Claim 177. Appellants understand that one of the Examiner's interpretations includes:

“... (i.e., selecting an SPE) that has a second expert qualification (i.e., the message about the authority of an SPE in the same Art Unit-having authority to approve that primary examiner's action) ”.
[Examiner's Answer, pages 4-5(citing MPEP Section 705.01(e))]

As best understood, this interpretation considers the first expert to be a primary examiner to whom a patent application has been assigned, and the second expert to be the SPE, wherein the SPE is considered to be “a senior examiner” in this examiner’s Art Unit (Examiner’s Answer, paragraph spanning pages 4 to 5).

MPEP Section 705.01(e) contains no indication of a process in which an SPE is selected, much less selected to “review and approve” the qualifications of a primary examiner to whom an application has already been assigned. In fact, MPEP Section 705.01(e) includes only a discussion of the limitations on the use of a “Patentability Report” practice. Appellants respectfully assert that nothing in MPEP Section 705.01(e) indicates that an SPE is selected.

The Examiner also asserts that MPEP Section 705.01(e) teaches that the examiner is selected by the group director:

“i.e. USPTO’s TC 3600 group director ‘assigns’ an examiner to examine a patent application” [Examiner’s Answer, page 3 (citing MPEP Section 705.01(e))].

But there is no teaching in MPEP Section 705.01(e) that supports this statement. Nonetheless, according to this other finding of the Examiner, the second expert (TC 3600 group director) selects a first expert (examiner). Appellants submit that such a situation is typical of many hierarchical organizations, where someone with higher skills (for example, a store manager) manages and selects among their subordinates (for example, cashiers) with lower skills. However, this is clearly the opposite of the claim limitation of Claim 177 highlighted above in which the second expert (with a higher expert qualification) is selected. In the Examiner’s example, the first expert is selected by the second expert. It would be nonsensical to argue that the second expert (“TC 3600 group director”) somehow selects himself.

The Examiner also asserts that MPEP Section 705.01(e) teaches, in a second interpretation:

“selecting a second expert (i.e., selecting an SPE)... (i.e., an SPE is considered as a senior examiner in the primary examiner’s Art Unit for consultation on a specific subject matter e.g., a current technology for MagLev train...; or a patent application on business method using a smart-card technology; a senior/primary examiner that specializes in another art unit dealing with smart-card technology is consulted by email via computer) is also selected to review and approve that examiner’s qualification/decision – i.e., the SPE must approve any correction from issued patent examining by that examiner”
[emphasis in original, Examiner’s Answer, page 4 (citing MPEP Section 705.01(e)].

As best understood, the Examiner is asserting that it was known to select an SPE who is considered to be a “senior examiner” for “consultation”, and also to select a senior/primary examiner from another art unit to review and approve that examiner’s qualification/decision. In this interpretation, the first expert of the claim limitation is apparently a patent examiner to whom a patent application has been assigned, and the second expert of the claim limitation is the SPE or possibly the senior/primary examiner of another art unit (Appellants cannot be sure). In either case, MPEP Section 705.01(e) does not recite a process in which an SPE is selected “for consultation on a specific subject matter”, nor does it disclose selecting “a senior/primary examiner that specializes in another art unit” who could “review and approve” the qualification/decision of a patent examiner to whom an application has already been assigned. Furthermore, MPEP Section 705.01(e) is silent regarding relative qualifications of “specialists” who “deal with claims directed to their specialty”. Accordingly, there is no basis for the Examiner’s conclusion that any aspect of the Patentability Report practice discussed in MPEP Section 705.01(e) necessarily involves selecting an individual such as an SPE

having a qualification higher than the qualification of a patent examiner to whom an application has already been assigned.

Even if MPEP Section 705.01(e) suggests specifically selecting an SPE for consultation, there is no suggestion that the SPE would “review and approve” anything related to the qualification of the assigned patent examiner. Instead, MPEP Section 705.01(e) indicates that if the Patentability Report practice is used, then the respective “specialists” must address only the claims directed to their specialty.

A variation of this interpretation would also fail to suggest the claim limitation. That is, if the *second expert* was the examiner, who was selected by a group director or SPE, this selected *second expert* (examiner) would not have an expert qualification which is higher than the *first expert* (group director or SPE) as required by the claim limitation.

The Examiner has yet a third interpretation of MPEP Section 705.01(e), which is:

“a group director can transfer an examiner to a different art unit for a better “fit” (an SPE can make his own request for this transfer), that examiner personal record is sent to a new supervisor (with/without electronic means; emails, telephone, word-processing) of said different art unit for reviewing qualifications” [Examiner’s Answer, page 5 (citing MPEP Section 705.01(e))].

But MPEP Section 705.01(e) does not recite any such process in which a group director transfers a patent examiner for a better “fit”, or in which an examiner personal record is sent to a new supervisor. No support exists in MPEP Section 705.01(e) for this asserted transfer process. Accordingly, there is no substantial evidence that this process was known in the prior art, and the Examiner’s assertion cannot form the basis for any rejection of Claim 177.

Consequently, MPEP Section 705.01(e) is not substantial evidence that could support the Examiner's assertion that the prior art teaches *selecting a second expert that has a second expert qualification which is higher than the first expert qualification (of a first expert for which a first expert qualification was received)*.

Furthermore, the Examiner has not shown that the references, alone or in combination, suggest the claimed subject matter of Claim 177 of *transmitting the first expert qualification to the (selected) second expert*. With respect to this element, the Examiner puts forth at least two interpretations of what was allegedly known, and cites only MPEP Section 1005 for support. Appellants understand that one of the Examiner's interpretations is:

"(e.g., via computerized telephone, or internal "transmitting" via email (i.e. using any computer communication means) said examiner's qualification to that group director/supervisor for a best match between examiner(s) to examining a specific customer's application)" [Examiner's Answer, page 5 (citing MPEP Section 1005)].

Appellants understand that in this interpretation, the *first expert* of the claim limitation is a patent examiner to whom a patent application might be assigned, and the *second expert* of the claim limitation is a group director or supervisor. But MPEP Section 1005 does not disclose a process in which an expert qualification is transmitted to any party, much less "using any computer communication means" to transmit an "examiner's qualification for a best match between examiner(s) to examine a customer's application." There is no explanation of how any description in MPEP Section 1005 could be interpreted as suggesting an *expert qualification; transmitting an expert qualification* of one expert to another having a

higher qualification; selecting a second expert, group director, or supervisor; or from whom a group director or supervisor would receive an expert qualification.

Appellants reassert that MPEP Section 1005, which is entitled “Exceptions to Partial Signatory Authority”, includes only a list. There is no discussion of transmitting expert qualifications, or of transmitting an expert qualification of one expert to a second (selected and having a higher qualification) expert. Nothing in MPEP Section 1005 hints at finding a “best match between examiners.”

Accordingly, MPEP Section 1005 is not substantial evidence that the asserted subject matter was known in the prior art.

In the second interpretation of MPEP Section 1005, the Examiner asserts: “this section inherently requires an examiner having Full/Partial-Signatory-Authority to sign a certain Office Action after he has been authorized to do so (after examiner’s qualification is reviewed by a group director and/or an SPE)” [Examiner’s Answer, pages 5 (citing MPEP Section 1005)].

Appellants’ understand the Examiner is asserting that it was known to have a group director review an examiner’s qualification and authorize an examiner to have Full/Partial Signatory Authority. But MPEP Section 1005 is not substantial evidence of such a process, as it does not describe how an examiner is delegated “full/partial signatory authority.”

The Examiner argues that the asserted process is somehow “inherent” in MPEP Section 1005, but the Examiner provides no explanation as to why any description in MPEP Section 1005 necessarily, and not probably, would require the asserted process. All that MPEP Section 1005 indicates is that partial signatory authority is somehow delegated; it does not provide any hint of how or by whom. Accordingly, there is no indication that such delegation is necessarily based on expert qualification, much less that such delegation would necessarily require

transmitting an expert qualification of one expert to another expert having a higher expert qualification for any purpose. Consequently, MPEP Section 1005 is not substantial evidence that could support the Examiner's assertion that the prior art teaches *transmitting the first expert qualification to the (selected) second expert*.

Moreover, Appellants respectfully submit that *transmitting the first expert qualification to the (selected) second expert* is not inherently or explicitly anticipated by any of the cited MPEP sections. The Examiner has accordingly failed to establish by substantial evidence that the specific method of Claim 177 was known in the prior art, and has not established an unrebuttable *prima facie* case of anticipation.

In addition, there has been no showing that the references, alone or in combination, suggest *receiving a signal from the second expert that indicates approval of the first expert qualification*. The Examiner again offers at least two interpretations of what was allegedly known in the prior art with respect to this claimed subject matter, and cites only MPEP Section 1005 for support. In a first interpretation of MPEP Section 1005, the Examiner asserts:

“i.e., The primary examiner's expertise allows him to interpreted correctly a prior art that agreeing by an SPE as a clear anticipation of that prior art; that SPE gives a signal to concur that qualification/decision; a supervisor “assigns” a specific patent application to said examiner after reviewing and approval of said examiner's qualification for a claimed specific subject matter”
[Examiner's Answer, page 6 (citing MPEP Section 1005)].

Appellants understand that in this interpretation, the *first expert* of the claim limitation is a primary examiner to whom a patent application might be assigned, and the *second expert* of the claim limitation is an SPE. But MPEP Section 1005 (and also MPEP Section 705.01(e)) does not contain any description of a process in which an SPE assigns a particular patent application to a particular patent

examiner, or one in which the SPE reviews an examiner's qualification or approves of such a qualification "for a claimed specific subject matter."

Nonetheless, according to this finding of the Examiner, the *second expert* selects a *first expert*. As discussed above, such a situation is typical of many hierarchical organizations, where one with higher skills manages and selects among his or her subordinates. However, such a situation is clearly the opposite of the claim limitation in which the *second expert* (with a higher expert qualification) is selected. The Examiner's example has the *first expert* being selected by the *second expert*. It would be nonsensical to argue that the second expert ("SPE") somehow selects himself.

Further, in this interpretation, there is no indication that this *expert qualification* of the examiner is *transmitted* to the SPE, and no indication that any sort of *signal is received from* the SPE that *indicates approval of the transmitted expert qualification of* the examiner, or by whom such a signal would be received. There is no indicated need for an SPE to "approve" (or disapprove) of the expert qualifications of any examiner.

Appellants note that MPEP Section 1005 includes only a list of "Exceptions to Partial Signatory Authority". There is no discussion of assigning applications, or of an SPE transmitting a signal that indicates approval of an expert qualification of a particular patent examiner. Nothing in MPEP Section 1005 even hints at such assigning. Accordingly, MPEP Section 1005 is not substantial evidence that the asserted subject matter was known in the prior art, nor that the specific claimed subject matter was known.

In a second interpretation of MPEP Section 1005, the Examiner asserts:

“a group director gives “Full-Signatory-Authority” to an examiner for decision-makings through a whole process of examining a patent application” [Examiner’s Answer, page 6 (citing MPEP Section 1005, page 1000-9)].

Appellants understand that the Examiner is again asserting (as discussed above with respect to the step of *transmitting*) that it was known to have a group director review an examiner’s qualification and authorize an examiner to have Full Signatory Authority. MPEP Section 1005 is not substantial evidence of such a process, as this section merely provides a list of exceptions to partial signatory authority. There is no hint as to how an examiner is “delegated full signatory authority”, and in fact MPEP Section 1005 only indicates that partial signatory authority is somehow delegated; it does not disclose how or by whom. There is no indication that such delegation is necessarily based on expert qualification, nor is there any indication that such delegation would necessarily require transmitting an expert qualification of one expert to another expert having a higher expert qualification for any purpose. The Examiner has not provided any explanation as to why any description in MPEP Section 1005 necessarily, not probably, would require the asserted process. Thus, MPEP Section 1005 is not substantial evidence that could support the Examiner’s assertion that the prior art teaches *receiving a signal from the second expert that indicates approval of the first expert qualification.*

Appellants note that the Examiner made a sweeping, conclusory statement that all of the features of Claim 177 are somehow “inherently taught” in the Manual of Patent Examining Procedure, pp. 700-5 to 700-8 and on page 1000-9. [Examiner’s Answer, page 6]. Appellants again respectfully submit that this

statement is an admission by the Examiner that the cited portions do not expressly disclose the above claimed subject matter and, as explained in the Appeal Brief, inherent anticipation requires that the missing descriptive material is necessarily present, not merely probably or possibly present, in the prior art, and would be so recognized by persons of ordinary skill in the art. Appellants could not identify any evidence in the record to support a finding that one skilled in the art would read any of the cited MPEP sections as inherently teaching any of the limitations of Claim **177** highlighted above. Specifically, the Examiner has not provided any evidence or explanation to establish that the described “Limitations as to Use” of a Patentability Report (MPEP Section 705.01(e)) or described “Exceptions to Partial Signatory Authority” (MPEP Section 1005) necessarily involve any specific processes that includes every step of the claimed method.

In view of the above comments, Appellants respectfully reassert that neither of MPEP Section 705.01(e) and MPEP Section 1005 teach or even suggest that the particular combination of claimed subject matter of Claim **177** was known to one of ordinary skill in the art. Further, the Examiner has failed to indicate substantial evidence in support of the assertions as to what was known. Accordingly, the Examiner has failed to establish a *prima facie* case of anticipation for Claim **177**, and thus the Section 102(b) rejection of Claim **177** should be reversed.

B. Claims 178 to 189

Appealed Claims **178 -189** stand rejected under 35 U.S.C. § 103(a) as being obvious in light of MPEP Section 705.01(e), Section 1005, Section 1002.02, and asserted subject matter that the Examiner does not even indicate any evidence of record could support. Appellants note that the rejections of Claims **178-189** appearing on pages 6 to 10 in the Examiner’s Answer are identical to those made

in the Office Action mailed August 25, 2005. Thus, since each of these rejections have already been addressed in the Appeal Brief, Appellants will not repeat the arguments that have already been provided, but simply reiterate that the Section 103(a) rejections cannot stand in view of those arguments.

C. The “Response To Arguments” Section

Appellants note that the Examiner’s Answer contains a “Response to Argument” section [see section 10, on pages 10-11] that purportedly addresses the arguments presented in the Appeal Brief traversing the rejections of Claims **177-189**. Appellants find the statements made in this “Response to Argument” section confusing insofar as (1) the Examiner does not link any particular assertion to any specific claim or claimed subject matter; and (2) the Examiner does not link any particular assertion to any cited evidence other than a general reference to the MPEP, so the Examiner’s reliance on the repeated assertions is still unclear.

In the Appeal Brief, Appellants asked the Examiner to clarify the assertions concerning rejections of Claims **177-189** that were repeated in section 7, on pages 7-8 of the Office Action dated August 25, 2005, (which statements were first made in the Office Action mailed December 18, 2002, on pages 1-2)]. Instead of clarifying the repeated arguments, the Examiner provided the following statements:

“Since the pending claims are very broad, they read on the cited references for a hierarchy management in an agency such as the USPTO... The cited reference clearly suggest what to do, who take what responsibility, where does it happen – MPEP does not explicitly disclose who to perform listed responsibilities; however, job functions described in MPEP already defines the functions for each role within USPTO. The examiner disagrees that the pending claims are original idea(s) of the applicants – what the applicants claim are not new; the

claimed concept is merely a second opinion request before making a decision (for personal interest, or for a company's operation).

The examiner presents a very clear evidence of USPTO's operation and its personnel's functionalities from a published MPEP document; however, the appellants still argue that the examiner has not provided a proper legal basis for rejecting any claim – the examiner strongly disagrees.” [Examiner’s Answer, section 10 on page 10].

Appellants submit that the above-cited statement illustrates that the Examiner has misinterpreted the pending claims. For example, claim 177 provides for several advantages not even recognized, much less disclosed or suggested, by the prior art of record. As discussed in the present application, by *selecting a second expert that has a second expert qualification which is higher than the first expert qualification (of a first expert)*, a higher level expert may be located. By *transmitting the first expert qualification to the second expert*, the second expert is in a position to evaluate the qualifications of the first (lower level) expert. By *receiving a signal from the second expert that indicates approval of the first expert qualification*, one can receive the approval of the first expert by the second expert.

Appellants submit that Claim 177 does not pertain to “a second opinion request before making a decision (for personal interest, or for a company's operation)” as asserted by the Examiner. Moreover, Claim 177 is not directed to “hierarchy management” as asserted; it is directed to providing a peer review feature wherein a first expert is qualified by a second expert (having superior qualifications) to perform a task. The Examiner has not provided any substantial evidence of record to support a *prima facie* case of anticipation for Claim 177, and thus Appellants respectfully assert that the Section 102(b) rejections must be reversed. Furthermore, as explained above, the Examiner has not provided any substantial evidence of record to support a *prima facie* case of unpatentability for

any of Claims **178-189**, and thus Appellants respectfully assert that the Section 103(a) rejections must also be reversed.

III. Conclusion

At least for the reasons stated above, which are supplemental to those submitted and described in the Appeal Brief, Appellants respectfully request reversal of the Examiner's rejections of the pending claims.

Respectfully submitted,

April 9, 2007
Date

/Stephan J. Filipek, Reg. No. 33,384/
Stephan J. Filipek
Attorney for Applicants
Registration No. 33,384
sfilipek@walkerdigital.com
203-461-7252 /voice
203-461-7253 /fax